REMARKS

The amendments to the claims are fully supported by paragraphs 42-56 of the specification and the claims as pending in the Amendment of November 13, 2006.

Applicants respectfully submit that the Examiner's position that the addition of the application number in paragraph 111 raises new matter is incorrect. Paragraph 111 states, "See U.S. Ser. No. _____, filed December 29, 2003, entitled "Composite Organic-Inorganic Nanoparticles." A search of the USPTO database shows that there is *only one* application filed December 29, 2003, entitled "Composite Organic-Inorganic Nanoparticles." The application number of this application is 10/748,336. In short, Applicants have not added new matter by including the application number. Instead, Applicants have made a perfectly permissible amendment to satisfy the requirements of the USPTO to provide the application number of a co-pending application cited in an application when the application number of the co-pending application was not available at the time of filing the application.

Claim Rejection - 35 U.S.C. §112

The rejections of claims 1-36 under 35 USC 112, second paragraph are respectively traversed. However, these rejections should be withdrawn in light of this Amendment.

Obviousness-Type Double Patenting Rejections

All of the obviousness-type double patenting rejections are *provisional* rejections as the Action states that "the conflicting claims have not in fact been patented." If these rejections are "provisional," then Applicants are under no obligation to respond to these rejections at this time.

Claim Rejection - 35 U.S.C. § 102

Claims 1-36 were rejected as being anticipated by Chan (U.S. Patent Application Publication 2004/0058328), Chan (U.S. Patent Application Publication 2004/0126820) or Chan (U.S. Patent Application Publication 2005/0208554). This rejection is respectfully traversed.

Foremost, the with respect to the first two references, the Examiner states that the "rejection is repeated for reasons already of record (e.g., Office action mailed December 23, 2005, paragraph bridging pages 6-7)." Applicants respectfully submit that the Examiner has provided no reason that would explain why each and every element and limitation of claims 1-36 are disclosed in each of the three Chan references applied to reject the claims. If this case were to go up on appeal, the Board of Appeal would have no clue for the Examiner's basis for the rejection. Thus, if the Examiner were to continue to maintain this rejection, Applicants request that the Examiner provide detailed reasons why each and every element and limitations of claims 1-36 are disclosed in each of the three Chan references.

A novelty of the present invention lies in the incorporation of a feature tag into nanobarcodes, wherein the feature tag has a property to provide error checking, encryption, and/or data reduction/compression during a fast and reliable method of scanning nanobarcodes by scanning probe microscopy (SPM). Applicants respectfully submit that neither of the Chan references disclose this feature of this invention, which is recited in all of the independent claims.

Claims 20-24 and 28 were rejected as being anticipated by Han. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has provided no reason that would explain why each and every element and limitation of claims 20-24 and 28 are disclosed in Han. Also, the Examiner states that the limitation regarding the property of the feature tag "to provide a quality control check for detecting nanocodes and/or distinguishes target nucleotides from self-assembled coded oligonucleotide probe structures" is an intended use. Applicants respectfully submit that this is not correct. This limitation is a functional limitation that recites a property of the feature tag of claim 20. To make is perfectly explicit that this limitation is a property, claim 20 now reads: "wherein the feature tag has a *property* to provide a quality control check for detecting nanocodes and/or distinguishes target nucleotides from self-assembled coded oligonucleotide probe structures." Please note: "A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is

nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)." See MPEP 2173.05(g).

Claim Rejection - 35 U.S.C. § 103

Claims 1-4, 9-15, 20-23, 26, 28-32 and 35 were rejected as being obvious over Mirkin in view of Nygren. This rejection is respectfully traversed.

As explained above, a novelty of the present invention lies in the incorporation of a feature tag into nanobarcodes, wherein the feature tag has a property to provide error checking, encryption, and/or data reduction/compression during a fast and reliable method of scanning nanobarcodes by scanning probe microscopy (SPM). Applicants respectfully submit that neither Mirkin nor Nygren disclose this feature of this invention, which is recited in all of the independent claims.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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